

REMARKS

In the final Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite; and rejected claims 1, 4-6, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,090,528 of Gordon et al. ("Gordon") in view of U.S. Patent No. 6,578,174 of Zizzo ("Zizzo").

Applicants filed an Amendment After Final in this case on September 30, 2005, in which Applicants proposed to amend claims 1, 6, 10, and 11. Applicants also advised the Examiner of a certified translation of their priority document that removes Zizzo as prior art against this application, thereby overcoming the Examiner's rejection under 35 U.S.C. § 103.

In a first Advisory Action mailed October 11, 2005, the Examiner indicated that the certified translation of Applicants' priority document had not been received. The Examiner further indicated, however, that the rejection of claim 1 under 35 U.S.C. § 112, second paragraph is "subsequently" withdrawn. See Continuation Sheet of the October 11 Advisory Action. The Examiner also indicated that Applicants' claim changes, as set forth in the Amendment After Final, would be entered "for purposes of appeal."

In a second Advisory Action mailed November 16, 2005, the Examiner acknowledged receipt of Applicants' priority document and that the rejection under 35 U.S.C. § 103 has been overcome ("[A]pplicants have submitted documentation cementing prior[it]y to overcome the 10[3] rejection." Continuation Sheet of the November 16 Advisory Action). The Examiner also asserted that "the claims (claim 11 for example) reflect non-statutory subject matter." Id.

Applicants gratefully acknowledge the Examiner's apparent withdrawal of the rejections under 35 U.S.C. § 112 and § 103.

As noted above, this Amendment accompanies a Request for Continued Examination ("RCE"). As indicated on the attached RCE transmittal form, Applicants request entry of the previously submitted Amendment After Final to insure that the claim changes set forth therein are entered, and not just for purposes of Appeal. In this Amendment, Applicants have cancelled claim 11. Accordingly, claims 1, 4-6, and 10 are pending in the above-captioned patent application.

Applicants respectfully disagree with the Examiner's assertion in the November 16 Advisory Action that the pending claims reflect non-statutory subject matter. Nevertheless, in order to advance prosecution of this application, Applicants have cancelled claim 11, the only claim which the Examiner specifically alleged as not reciting statutory subject matter. Applicants note that independent claims 1 and 6 are directed toward "[a] method of producing a semiconductor device." In addition, independent claim 10 recites "[a] program product for causing a computer system to produce a semiconductor device," which includes "a recording medium" and "first, second, and third instruction means."

Pursuant to the U.S. Patent and Trademark Office's Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (the "Guidelines"):

[T]o be eligible for patent protection, the claimed invention as a whole must accomplish a practical application.

Emphasis added. The Guidelines at page 1.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is "useful, tangible and concrete."

Emphasis in original. The Guidelines at page 38.

Accordingly, since each of independent claims 1, 6, and 10 are directed either to a method of producing a semiconductor device or a program product for causing a computer system to produce a semiconductor device, Applicants submit that each of these claims is for a "practical application," and thus each is directed toward statutory subject matter. Claims 4-6, which depend from claim 1, are likewise deemed to recite statutory subject matter.

Thus, in light of the foregoing, and in view of the cancellation of claim 11, Applicants submit that this application is in condition for allowance. A timely issuance of a Notice of Allowance is earnestly requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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